II. Claims 6-8, drawn to methods for prolonging the life-span of a patient with a prostate carcinoma, comprising introducing into the patient a nucleic acid encoding p27, classified in class 514, subclass 44.

In response, applicants hereby elect Group I, claims 1-3, with traverse, for prosecution at this time.

REMARKS

The Examiner alleged that the inventions of Groups I and II are distinct, each from the other, because of the following reasons. Allegedly, the inventions of Groups I and II are unrelated in that: (1) the vector encoding p27 of the invention of Group II is not used in the method of the invention of Group I; (2) the method of the invention of Group II is performed in vivo under physiological conditions substantially different than those involved in the in vitro methodology of the invention of Group I; and (3) the method of the invention of Group II does not utilize or require the in vitro detection of either p27 RNA or protein.

Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application. Under M.P.E.P. §803, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

The inventions of Groups I and II are not independent. Under M.P.E.P. §802.01, "independent" means there is no disclosed relationship between the subjects disclosed. The inventions of Groups I and II are drawn to methods relating to p27 detection and introduction, respectively. Applicants therefore maintain that the Groups are not independent and restriction is not proper.

Furthermore, under M.P.E.P. § 803, the Examiner must examine the application on the merits if examination can be made without serious burden, even if the application would include claims to distinct or independent inventions. That is, there are two criteria for a proper requirement for restriction: (1) the invention must be independent and distinct, and (2) there must be a serious burden on the Examiner if restriction is not required.

Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction were not required, because a search of the prior art relevant to the claims of Group I would necessarily turn up the prior art relevant to the claims of Group II, and *vice versa*. Since there is no burden on the Examiner to examine Groups I and II together in the subject application, the Examiner must examine the entire application on the merits.

In view of the foregoing, applicants maintains that restriction is not proper under 35 U.S.C. §121 and respectfully request that the Examiner reconsider and withdraw the requirement for restriction.

No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

5/27/01
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